

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of )  
David B. Campo )  
Serial No. 10/796,664 ) Group Art Unit: 3672  
Filed March 8, 2004 ) Examiner: Daniel Stephenson  
EXPANDER FOR EXPANDING A TUBULAR ELEMENT ) June 12, 2006  
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COMMISSIONER FOR PATENTS  
Alexandria, VA 22313-1450

Sir:

**REQUEST FOR REVIEW**

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. The request is being filed with a Notice of Appeal. The reasons for requesting review are:

- I. The references do not disclose each and every element of the claimed invention; therefore, the references do not anticipate the claimed invention.
- II. Examiner has failed to provide a *prima facie* basis for rejection under 35 U.S.C. § 103(a) because the references do not disclose all the limitations of the claimed invention.

In the Office Action dated 17 March 2006, Examiner rejects claims 1-3, 9, and 10 under 35 U.S.C. §102(b) as anticipated by WIPO document WO 02/291199 to Cook (hereafter Cook). Examiner further rejects claims 4-6 under 35 U.S.C. §103(a) as being unpatentable over Cook in view of pre-grant publication US20050056433 to Ring (hereafter Ring). Finally, Examiner rejects claims 7-8 under 35 U.S.C. §103(a) as being unpatentable over Cook in view of Ring as applied to claim 5 and further in view of pre-grant publication US2002/0033262 to Musselwhite.

**I. The references do not disclose each and every element of the claimed invention; therefore, the references do not anticipate the claimed invention.**

With respect to claim 1, Cook does not disclose converting the expandable mandrel to a first expansion diameter *while the expandable mandrel is within the casing*. Examiner asserts that converting should be read broadly as preparing the mandrel in a first diameter. Even if one were to use this broad interpretation of the term, the mandrel in Cook is not converted *after* it is placed within the wellbore while it is *within the casing*. The preparation of the mandrel is completed at the surface prior to installations in the well.

In the Office Action dated 17 March 2006, Examiner states that this argument has been fully considered, but is not persuasive claiming that “while the method steps are listed in a certain order in the claim, that order is not necessarily the order which they must be performed unless there are transitional terms.” Examiner argues that the step of converting the mandrel to a first diameter within the casing may be performed *outside* the wellbore prior to the casing being inserted. Applicant respectfully disagrees.

Claim 1 claims a method for providing a casing in a wellbore. Even when Examiner’s argument about the order of steps in a claim is considered, Cook still does not disclose all the elements of claim 1 because the mandrel is not converted to a first diameter *while it is within the casing*. Figures 1a through 1f show the expandable mandrel (130, 115) in a first diameter. The mandrel was converted to this diameter when it was assembled outside the casing. Figure 1g shows the mandrel converted to a second diameter after the upward shock load is applied pulverizing over-expansion

sleeve 130. See page 21, lines 10-19. The mandrel in Cook is only convertible these two diameters and the mandrel is not converted to the first diameter *while it is within the casing*. Cook does not disclose each and every element of claim 1; therefore claim 1 is not anticipated by the reference. Claims 2, 3, 9, and 10 depend from allowable claim 1 and merely add additional elements thereto. Therefore Applicant respectfully requests that the rejection of claims 1-3, 9, and 10 under 35 U.S.C. §102(b) be withdrawn and the claims formally allowed at this time.

**II. Examiner has failed to provide a prima facie basis for rejection under 35 U.S.C. § 103(a) because the references do not disclose all the limitations of the claimed invention.**

MPEP §2143.03 states:

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

As argued earlier, Applicant respectfully submits that the references do not disclose converting the expandable mandrel to a first expansion diameter while the expandable mandrel is within the casing as claimed in claim 1. Claims 4-6 and 7-8 depend from allowable claim 1. Because all of the claim limitations are not taught or suggested by the prior art, Examiner has failed a prima facie case of obviousness. Applicant respectfully requests that the rejection of claims 4-6 and 7-8 under 35 U.S.C. §103(a) be withdrawn and the claims formally allowed at this time.